



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,564	02/18/2004	James P. Quigley	1361.036US1	9290
21186 7590 04/01/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
SANG, HONG				
ART UNIT		PAPER NUMBER		
1643				
MAIL DATE		DELIVERY MODE		
04/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,564

Applicant(s)

QUIGLEY ET AL.

Examiner

HONG SANG

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

RE: Quigley et al

1. Applicant's response filed on 1/22/2008 is acknowledged.
2. Claims 1 and 34-36 are pending. Claims 2-33 have been cancelled.
3. Claims 1 and 34-36 are under examination.

Priority

4. The objection to Applicant's claim of priority under 35 U.S.C. 119(e) for claims 34-26 is withdrawn in view of applicant's persuasive arguments.

Rejections Withdrawn

5. The rejection of claims 34-36 under 35 U.S.C. 112, first paragraph because of new matter is withdrawn in view of applicant's persuasive arguments.

Response to Arguments

Claim Rejections - 35 USC § 102

6. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by accession no. BAB15511 (see IDS, first seen at NCBI 9/30/2000) is maintained.

The response states that BAB15511 discloses an amino acid sequence that was discovered in a human cDNA sequence project and the amino acid sequence was deduced from sequence of the cDNA clone. The response states that BAB15511 does

Art Unit: 1643

not disclose a protein isolated from signet-ring cell carcinoma cells or synthesized in eukaryotic cell.

Applicant's arguments have been carefully considered but are not persuasive. While BAB15511 does not disclose that the protein is glycosylated, because it is found in human signet-ring cell carcinoma, it would be glycosylated. Moreover, a disclosure of an amino acid sequence would indicate to one skilled in the art that the person who disclosed the sequence was in possession of the protein.

7. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by accession no. Q9H5V8 (See accession no. Q9H5V8 information sheet, and revision history, release date: 3/1/2001) is maintained.

The response states that the Q9H5V8 report indicates that Watanabe et al. submitted a sequence determined from a human cDNA sequence project. The response states that Q9H5V8 does not disclose a protein that is glycosylated.

Applicant's arguments have been carefully considered but are not persuasive. While Q9H5V8 does not disclose that the protein is glycosylated, the human protein as disclosed by accession no. Q9H5V8 would be inherently glycosylated. Moreover, a disclosure of an amino acid sequence would indicate to one skilled in the art that Watanabe et al. were in possession of the protein.

Conclusion

8 Claim1 is rejected. Claims 34-36 are objected to as being dependent from a rejected claim.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG SANG whose telephone number is (571)272-8145. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1643

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hong Sang, Ph.D.

Art Unit 1643

3/14/08

/Christopher H Yaen/

Primary Examiner, Art Unit 1643